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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09,764,688	01-16-2001	Mary Ann Fitzmaurice	40655.0100	6906

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07/29/2002

EXAMINER
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LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 07/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/764,688

Applicant(s)

FITZMAURICE ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Prelim. Amdt/Amendment*

1. Receipt is acknowledged of the Amendment filed 06 March 2002.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 20-22, 24-25, 27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Masaki (JP 08-244,385).

Re claims 20-22, 24-25, 27 and 29, Masaki discloses a multiple-service card 1 associated with which there is a service partner (e.g., university if used as a student ID card, a business-firm if used as a personnel certificate, or a club/department if used as a membership card, etc.), a primary party (DNP) and a holder, the card 1 comprising a first side 1b and a second side 1a, the first side 1b having a first indicia associated with the primary party, the second side 1a having second indicia associated with the service partner, which is a provider of membership club services (English abstract and detailed description, paragraph [0008], the second indicia including a service partner membership member, a magnetic strip 2a that contains account information in machine readable form, an image of the card holder (see figs. 1a & 1b; English translation: abstract and paragraph [0008] through paragraph [0011])).

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*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackenthun (US 5,969,318) in view of Brake, Jr. et al (US 6,032,136) and Sullivan (US 6,386,444 B1).

Re claims 1-19, Mackenthun discloses a method of providing a multiple-service card. The method comprises the steps of receiving an application for a multiple-service card from a consumer 10; communicating/transmitting the credit card information to a provider of credit services [40A-40I]; causing a multiple-service card to be sent to the consumer by the card manufacturing apparatus [22, 23]. Request a card administrator 30; the card administrator 30 communicating with a card service engine [40A-40I]; the card service engine [40A-40I] communicating with card generator [22, 23]; the card generator [22, 23] communicating with the card administrator 30; the administrator 30

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communicating with the consumer 10 for confirmation (figs. 1-6; col. 4, line 30 through col. 10, line 54).

Mackenthun fails to teach or fairly suggest the steps of authorizing the credit card information; and the communicating to the service partner; and that the multiple-service card is configured for providing a primary party's services and a service partner's services.

Brake Jr. et al teaches the above limitation by verifying the customer's information before adding a secondary service to the primary service 25 and both primary feature/indicia 72 and secondary feature/indicia 74 present on the multiple-service card (figs. 1-3; col. 4, line 58 through col. 6, line 26).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Brake Jr. et al into the teachings of Mackenthun in order to provide Mackenthun with a universal system, wherein the card can be used in multiple applications due to its multiple-services (e.g., primary service, secondary service, and other additional services, etc. (Brake Jr. et al: col. 5, lines 30-40)). Furthermore, such modification would provide Mackenthun with a more secure system, wherein the customer's identity can be verified via authorizing step, preventing fraudulent user of the card. Accordingly, such modification would have been an obvious extension as taught by Mackenthun, well within the ordinary skill in the art, and therefore an obvious expedient.

Mackenthun as modified by Brake Jr. et al fails to teach or fairly suggest the method of receiving at a service partner establishment an application and the service partner information related at least in part to membership in the service partner establishment.

Sullivan teaches the above limitation in figs. 2 & 5; col. 7, line 1 through col. 8, line 3; and col. 8, line 50 through col. 9, line 45.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Sullivan into the teachings of Mackenthun/Brake Jr. et al in order to provide Mackenthun/Brake Jr. et al with a more convenient system wherein the user can apply for both primary service (e.g., credit card, etc.) and secondary service (e.g., membership card, etc.) at one place (e.g., establishment, department stores such as Circuit City, Costco, etc.), and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Mackenthun/Brake Jr. et al, and therefore an obvious expedient.

7. Claims 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masaki in view of Yang (US 6,224,109 B1). The teachings of Masaki have been discussed above.

Re claims 23 and 26, Masaki has been discussed above and further discloses the first indicia including an account number and a name of the holder (fig. 1a) but fails to teach or fairly suggest the first indicia including an expiration date and the second indicia including a space for a signature.

Yang teaches the above limitation with an expiration date 25 and a space for a signature 28 (figs. 1 and 2; col. 4, line 55 through col. 5, line 33).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Yang into the teachings of Masaki in order to provide Masaki with a more secure system wherein the signature of the card holder can be verified (i.e., by comparing the signature on the card and the signature on the receipt), thus preventing the card from being used by an unauthorized holder. Furthermore, such modification would provide Masaki with a capability of preventing the card from being used longer than its paid time (e.g., one year membership), the expiration date on the card would help the operator/cashier to prevent fraudulent use and also would help the card holder to know when his/her is expired, thus providing a more user-friendly system.

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Accordingly, such modification would have been an obvious extension as taught by Masaki, and therefore an obvious expedient.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masaki in view of Blank (US 6,089,611). The teachings of Masaki have been discussed above.

Re claim 28, Masaki has been discussed above but fails to teach or fairly suggest a barcode representing a service partner membership number.

Blank teaches the above limitation with barcode 22 representing a service partner membership number (fig. 1b; col. 5, lines 40+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Masaki in order to provide Masaki with a more organized and secure system wherein the system can keep track on the number of customers of each individual service partner. Furthermore, such modification would provide Masaki with the capability of determining whether or not a valid member (i.e., by reading the membership number). Accordingly, such modification would have been an obvious extension as taught by Masaki, and therefore an obvious expedient.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

A new ground of rejection was made including new cited references (Yoshioka et al; Masaki and Yang) to meet the further defined limitation of the claim invention (i.e., "receiving from a service partner establishment an application ..." and "membership card/service partner information related at least in part to membership in the service partner establishment...") and new added claims.



**Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Barnett (US 6,068,184); Taskett (US 5,991,748); Shomron (US 5,259,649); Lalonde (US 5,855,230); Yoshihiro (JP 08,324,163); Lalonde (US 5,477,040); Story (US 6,099,043); Chapin Jr. (US 5,883,377); Hennige (US 5,276,311); Taskett (US 5,923,734); Thomas (US 6,038,292); Laing et al (US 5,534,857); Wentker et al (US 2002/0,040,936 A1); (DE 297 02 538 U1); Yamamoto (JP 08-244,385); Carmichael et al (WO 01/55955 A1) and Costco Membership Card (The Choice is Yours) are cited as of interest and illustrate a similar structure to a multiple-service card system.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M-T and TR-F 8:30-7:00.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
Uyen Chau N. Le

July 25, 2002

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
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